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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/631,542	08/03/00	IMANAKA R	MAT-3720US3

EXAMINER	
GRANT, C	
ART UNIT	**PAPER NUMBER**
2611	9

TM02/0712

RATNER & PRESTIA
P O BOX 980
VALLEY FORGE PA 19482

DATE MAILED: 07/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)
*U.S. GPO: 2000-473-000/44602

1- File Copy

Office Action Summary

Application No.	Applicant(s)
09/631,542	IMANAKA
Examiner	**Art Unit**
Christopher Grant	2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *May 9, 2001* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *14-16* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *14-16* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 8

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

Reissue Applications

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 14-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14, 17 and 18 of co-pending Application No. 09/594,152. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in breadth. For example:

a) the claimed "*recording medium for recording information*" (lines 1-3) of current application claim 14 corresponds to "*recording medium used for an information on demand system*" (lines 1- of the '152 co-pending application claim 17;

b) the claimed "*recording medium for recording information*" (lines 1-3) of current application claim 14 corresponds to "*recording reproducing apparatus for recording the information into a recording medium*" (lines 7-9) of the '152 co-pending application claim 17;

c) the claimed "*wherein recording of said information...effects charges for said information...*" (lines 8-10) of current application claim 14 corresponds to "*charging means for charging a different amount....*" (lines 10-14) of the '152 co-pending application claim 17; and

d) the claimed "*an identifier, wherein said information is recorded...based on a presence of said identifier*" (lines 4-7) of current application claim 14 corresponds to "*wherein a unique identification (ID) information is detected.....*" (lines 15-19) of the '152 co-pending application claim 17.

Therefore, it would have been obvious to one of ordinary skill in the art to readily recognize that the conflicting claims are different definitions or descriptions of the same subject matter varying in breadth.

The limitations recited in current application claim 14 corresponds to the limitations recited in the '152 co-pending application claim 14.

The limitations recited in current application claim 15 also corresponds to the limitations recited in the '152 co-pending application claim 17.

The limitations recited in current application claim 16 corresponds to the limitations recited in the '152 co-pending application claim 18.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 14-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14 and 22 of co-pending Application No. 09/631,540. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in breadth. For example:

a) the claimed "*A recording medium for recording information...*" (lines 1-3) of current application claim 14 corresponds to "*An information receiver ...recording said information on a recording medium*" (lines 1-4) of the '540 co-pending application claim 14;

b) the claimed "*wherein recording of said information...effects charges for said information...*" (lines 8-10) of current application claim 14 corresponds to "*said information charged differently depending....*" (lines 5-8) of the '540 co-pending application claim 14; and

c) the claimed "*an identifier, wherein said information is recorded...based on a presence of said identifier*" (lines 4-7) of current application claim 14 corresponds to "*said recording medium evaluated ....includes an identifier prior to permitting recording....*" (lines 9-13) of the '540 co-pending application claim 14.

Therefore, it would have been obvious to one of ordinary skill in the art to readily recognize that the conflicting claims are different definitions or descriptions of the same subject matter varying in breadth.

The limitations recited in current application claim 15 also corresponds to the limitations recited in the '540 co-pending application claim 14.

The limitations recited in current application claim 16 corresponds to the limitations recited in the '540 co-pending application claim 22.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Note to applicant

4. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173.

Conclusion

5. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872 9314 (for formal communications intended for entry and for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Grant whose telephone number is (703) 305-4755. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 4700.

Christopher Grant

Christopher Grant
Primary Examiner
July 11, 2001